

REMARKS

Claims 1 through 39 are pending; claims 9 and 15 are amended while claims 21 through 39 are newly presented.

Claims 9 through 20 were rejected under both the first and the second paragraphs of 35 U.S.C. §112 as (1) as possibly failing to describe the claimed invention "in such full, clear, concise and exact terms as to enable anyone skilled in the art to make and use the same, and/or (2) for failing to particularly point out distinctively claimed subject matter which Applicant regards as his invention. Applicant respectively traverses these rejections for the following reasons.

The Examiner questioned whether the specification provides "clear support for the twice entering [entry?] of the code". The Examiner's attention is invited to column 1, lines 60 and 61, together with column 1, lines 65 and 66 of Applicant's specification. Both citations expressly contemplate at least the initial entry of the code followed by the subsequent entry discussed by the citations. Additionally, column 2, lines 30 and 31 require at least two entries of codes, independent of whether both codes match or are different. Moreover, a careful reading of Figures 3(A), 3(B) indicates at least a first entry of the code by steps 201-226, a setting of a code by steps 229-233, and a comparison of a latter entry of code 2 and earlier entry of a code in steps 234. Clear support is therefore provided for the multiple entry of the code.

Second, the Examiner questioned the "lack of any release from the standby mode",

apparently, within both the claims and the original specification. Steps 200, initially described in column 1, lines 41 and 42, define maintenance of the "system power standby state" until the occurrence of a "lock-function access" defined by steps 200, and further explained in column 3, beginning with lines 43. Activation (as opposed to the Examiner's "release") occurs in response to the determination that "there is a key input by checking key-data input from either keyboard 101 or remote-control receiver 102 through bus line 1 or bus line 2 (step 201). Accordingly, clear support is provided. The Examiner's assertion that the functions are not recited in the pending claims is questionable. Before application of the first paragraph of 35 U.S.C. §112, the Examiner must first consider the second the second paragraphs of §112 which mandates that it is the Applicant, rather than the Examiner, who determines the subject matter that the Applicant regards as his invention. Moreover, these features are already defined in claims 11 and 17, among others.

Third, the Examiner argues that "selectively" is not clearly supported. It is understood that this comment refers to the rejection under the first paragraph of 35 U.S.C. §112. Applicant's disclosure of either a remote control or a key pad for entry of numerical keys having values extending from 0-9 is the epitome of "selectivity".

Fourth, the Examiner questioned use of the conjunction "and" instead of "or". Applicant notes that in the past two decades the Examiner has, in other applications, taken precisely the opposite position. In accordance with the Examiner's implicit suggestions however, claims 9 and

15 have been amended to substitute "or".

Fifth, the Examiner questioned use of "a said", and suggested substitution of "said". The Examiner's suggestion has been adopted.

Sixth, the Examiner questioned whether "component" in line 6 of claim 5 is accurate. Applicant has amended line 6 to conform with the previous introduction of "components".

Seventh, the Examiner questioned whether "broadcast" in line 5 of claim 15 is inaccurate. Actually, "broadcast" has meaning extending from sowing of seed to propagation of audio sounds and radio frequencies. The use of "broadcast" in claim 15 is accurate. Typically, audio sounds are broadcast via audio frequency source such as a speaker.

Eighth, the Examiner generally asserts that claims have contradicting limitations that include output signals not being generated, yet a mixer generates output. The Examiner's attention is invited to Figure 2. Although, mixer 106 may generate output, claim 9 contemplates prevention of "said first audio signal from being output to said mixer", rather than the output of the mixer itself from being generated when lead 6 is grounded via the of transistor Q1. Recognizing that grounding of this lead reduces any voltage applied to mixer 106 by audio processor 103 to the ground, or local reference potential, it is difficult to understand why the Examiner views the limitation as being a

"contradicting limitation that include [-s] an output signal not being generated. Regardless what output signal is, or is not being generated (ignoring the fact that this is not the language of Applicant's claims), the grounding of lead 6 reduces the potential of that signal as a function of the reference, or ground voltage.

Ninth, the Examiner asserts the claim 20 "that uses similar terminology to express a totally different concept". The Examiner quotes line 6 as "selectively generating a blocking code in dependence..." and asserts that this is "inconsistent" with any of the other claims and basically a misstatement of the invention. It is difficult to understand the Examiner's assertion. "Blocking code" is actually the correct translation of "locking code". The Examiner may appreciate the fact the letter "b" may have been lost during the translation in 1990. In any event, video circuit 107 certainly "blocks" the application of any video output signal from circuit 103 by mixer 106 to lead 121. Whether that "blocking" is the result of "locking" of the circuit, or alternatively, a "blocking" of the application of a video signal through an expedient such as a grounding of the lead conducting that signal, this cannot be determined to be of indefiniteness under 35 U.S.C. §112, or of a lack of enablement under the first paragraph of §112 given the clear disclosure provided by Figure 2.

Tenth, the Examiner's assertion that claim 20 "uses similar terminology to express a totally different concept" is an unusual statement from an experienced U.S. patent Examiner. Under U.S. practice, the language of the claims, rather use the "similar terminology" used by claim 20 defines

the metes and bounds of Applicant's invention; in European patent practice however, the claims define a central "concept". European style of "concept" claim drafting is inappropriate in U.S. practice, and the rejection based upon the occurrence of a "different concept" between claims using "similar terminology" is inappropriate under either the first or the second paragraph of §112. Its withdrawal is required.

Eleventh, the Examiner asserts that line 6 of claim 20 recites "selectively generating a blocking code in dependence ...is inconsistent with any of the other claims and it is basically a misstatement of the invention". The Examiner's attention is invited to column 1 of Applicant's specification, beginning with line 20, which describes the process and circuit "generally used for the purpose of keeping children from watching adult video programs ..." and the use of "secret codes being input by the viewer" when locking a consumer appliance, in order to prevent viewing of those "adult video programs" by children. It is difficult to understand how Applicant's selective generation of a blocking code "in dependent upon" evaluation of content portrayed by a first video signal" is a misstatement of Applicant's invention. In view of the foregoing demonstration of complete consistency between the language questioned by the Examiner and Applicant's originally filed specification, withdrawal of this basis for the rejection is required.

COPY

Twelfth, the Examiner questions whether line 6 "is inconsistent with any of the other claims". Applicant invites the Examiner's attention to the fact that claim 20 is an independent claim. Reading

*RECEIVED
APR 22 1998
U.S. PATENT AND TRADEMARK OFFICE*

of limitations from other claims not dependent upon claim 20, is improper. Accordingly, withdrawal of this basis of the rejection is mandated.

Thirteenth, the Examiner asserts that the last line of claim 20 (Applicant understands that the Examiner is referring to lines and 7 and 8) is not accurate "since the system is already in a power stand-by mode," and inquires "so what can possibly be blocked?" The Examiner's confusion is not understood. The Examiner is reminded that reference must be had to the second paragraph of §112 before application of the first paragraph of §112. It is Applicant, who by his choice of language in his claims, determines the subject matter that Applicant, rather than the Examiner, believes to be the subject matter of this invention. Here, Applicant expressly states that the response "to said blocking code" is "by blocking transmission . . ." The fact that the blocking code is generated "during said system power stand-by mode of operation" is completely consistent, as was earlier explained in these remarks, the flowchart illustrated by Figs. 3A, 3B. Step 200 determines the power status of the system and, as is explained in column 3, beginning with line 45, if the system is in the power stand-by status, the system then determines whether "there is key input". As is noted by the Examiner's subsequent two sentences on page 2 of the Examiner's comments, the blocking occurs subsequently to step 200. Consequently, there is no confusion between claim 20 and Applicant's specification.

COPY

Fourteenth, the Examiner asserts that the last two lines recite "transmission of said first video

COPY

signal" and that this contradicts the language of lines 2 and 3 where the "first video signal" is "transmitted for reception." The Examiner has confused of reading of claim by taking phrases of claim 20 in isolation, rather than reading claim 20 in its entirety. Lines 2 and 3 contemplate a future transmission, namely "a first video signal *to be* transmitted *for reception* by a video display apparatus" while lines 7 and 8 contemplate the blocking of that "transmission of said first video signal to said video display apparatus". The Examiner then asserts that the language in these claims is extraordinarily confused and causes the meaning to be totally obscured. The Examiner's comment is unjustified however, in view of the foregoing demonstration of consistency between lines 2 and 3 and lines 7 and 8. Accordingly, withdrawal of both of these rejections is required.

COPY

The Examiner objected to claim 9 through 20 as lacking underlining. Accordingly, claims 9 through 20 have been all amended to incorporate the underlining, and newly introduced matter has been double underlined while deleted matter has been bracketed. Upon allowance of all pending claims, Applicant will provide clean copies with underlining of all allowed claims. The Examiner is requested to suspend requirements of these formalities, until indication of allowable subject matter.

Claims 9 through 19 were alternatively rejected under 35 U.S.C. §102(b) as either anticipated by, or under 35 U.S.C. §103 as rendered obvious over Bonneau, U.S. Patent No. 4,510,623 or Amano, U.S. Patent No. 4,620,229. Applicant respectfully traverses these rejections for the

COPY

following reasons.

Bonneau '623, as does DiLorenzo, U.S. Patent No. 4,317,213, teaches interference with and avoidance of any reception of the carrier frequency of a corresponding television broadcast signal. See Bonneau '623 at column 1, lines 40-48 and column 2, lines 34-38.

Applicant's claims 9 and 15, together with newly presented independent method claims 21, and newly presented independent video system claims 29 and 35, expressly define muting circuits that respond to control signals by preventing the video, or alternatively the audio, signal from being output. This structure is neither taught nor suggested by Bonneau '623. Accordingly, there is no anticipation of any of the rejected or newly added claims.

copy

Moreover, it is Applicant's muting, in conjunction with the use of a microprocessor based controller receiving inputs from a user, that advantageously enables Applicant's user to selectively block the use of video and audio signals to provide illicit entertainment. In view of these and other beneficial results flowing from these distinctions, as well as the absence of any *prima facie* showing of obviousness, this rejection must be withdrawn.

Amano '229 discloses a remote control technique for either initialiating particular programing functions or toggling between four classes of different vision displays provided by

copy

television screen. Amano '229, like Bonneau '623, doesn't receive block channels consequently, both references lack Applicant's "video signal processor receiving and processing a first video signal", as defined by line 8 of claims 9 and 15. This, in combination with Applicant's muting circuit features, neither taught nor suggested by Amano '229, advantageously enable Applicant's user to evaluate and selectively block video display illicit or otherwise undesired video material, regardless whether that material has been received via cable, television broadcast or replay from a DDD or magnate tape. In view of these advantageous results flowing from these distinctions, there is neither a *prima facie* showing of obviousness under Section 103, nor anticipation under Section 102. Accordingly, withdrawal of these rejections is required.

COPY

Applicant has newly presented claims 21-28, patented upon allowed claims 1-8, with newly presented claims 21-28 broadly define a "video system" rather than a video cassette record. Accordingly, newly claims 21-28 are deemed allowable and patentably distinguishable over the art for the same reasons as claims 1-8. Applicant has also newly presented claims 29-39, patented respectively upon pending claims 9-19, but amended to corporate alternative suggestions arising from the Examiner's questioning of the language of claims 9-19 in conjunction with rejections under the second paragraph of Section 112. Claims 29 preserves the patenably distinguishing features of claims 9-19, therefore deemed to be allowable and patentably distinguishable over the prior art, for the same reasons as claims 9-19.

Applicant notes that the Examiner improperly failed, without any explanation or comment,

COPY

to consider the McDaniel paper that was timely and properly submitted in Applicant's Information Disclosure Statement. The Examiner's attention is invited to the postcard receipt dated 17 February 2000 that was already filed during the prosecution of this application on the 10th of August 2000, together with Applicant's Petition bearing that date. Seventeen (17) references were listed; all seventeen were also listed in Applicant's PTO-1449. In view of the certification by the Commission of the timely filing and receipt of the reference, the Examiner is requested to immediately correct the PTO-1449, and to provide Applicant with a corrected copy of the PTO-1449 showing that the Examiner has in fact timely considered the McDaniel paper. The Examiner's assertion that the reference was not submitted and was not readily available is incorrect in view of the postcard receipt and Applicant's PTO-1449.

The Examiner asserted that the reissue application was without an offer to surrender the original patent. This is incorrect and improper. The Examiner's attention is invited to the first full paragraph of the Declaration signed by the Assignee, which states that "I offer to surrender the original grant of the patent, but that patent is lost and has become unavailable." Full compliance with 37 C.F.R. §1.178 is in evidence and of record. Accordingly, the Examiner is requested to acknowledge that offer.

COPY

In view of the above, it is submitted that all claims 1-39 of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the

COPY

Examiner is requested to telephone applicant's attorney.

A fee of \$1,302.00 is incurred by addition of extra claims in this Amendment. A Petition for a three-month extension of time along with the \$890.00 extension fee is also concurrently filed with this Amendment. Applicant's two checks drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N. W., Suite 300
Washington, D.C. 20005
(202)408-9040

COPY

Folio: P51671RE
Date: 1 February 2001
I.D.: REB/jx

COPY